

Application No. 10/049,694  
Paper Dated: January 20, 2004  
In Reply to USPTO Correspondence of August 22, 2003  
Attorney Docket No. 0388-020199

**REMARKS**

The Office Action of August 22, 2003 has been reviewed and the Examiner's comments carefully considered. The present Amendment amends independent claim 1 and adds new claims 7-9 in accordance with the originally-filed specification. Claims 1-9 remain in this application.

Initially, the Examiner has objected to the figures of the present application for the various reasons set forth in paragraphs 2-4 of the Detailed Action. Specifically, the Examiner asserts that Fig. 13 should be accompanied by a legend labeling it "prior art", since only that which is old is illustrated. Further, the Examiner requests that the thermoplastic of the body as claimed in claims 4-6 be reflected by proper cross-hatching of the sectional views. Finally, the Examiner believes that the reference numeral "7a" in Fig. 9 should be "7b". Applicants are in full agreement with the Examiner regarding these objections. Accordingly, the Examiner's suggested modifications have been adopted in full and reflected in the enclosed and amended drawing sheets. Applicants respectfully request approval and entry of the enclosed modified figures.

Substantively, the Examiner has rejected all of claims 1-6. Specifically, claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being obvious over Japanese Patent No. 153975 (hereinafter "JP '975") in view of Japanese Patent No. 57-50927 (hereinafter "JP '927"). Further, claims 1 and 3 stand rejected under 35 U.S.C. § 103(a) as being obvious over the prior art bottle illustrated in Fig. 13 of the present application in view of U.S. Patent No. 5,649,648 to Lier et al. (hereinafter "the Lier patent"). Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as being obvious over JP '975, JP '927 and in further view of U.S. Patent No. 2,688,424 to Keiter. Finally, claims 4-6 stand rejected under 35 U.S.C. § 103(a) as being obvious over JP

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‘975, JP ‘927, the Lier patent and in further view of either European Patent No. 0312725

(hereinafter “EP ‘725”) or U.S. Patent No. 5,624,057 to Lifshey.

Independent claim 1 of the present application has been modified by the foregoing Amendment. Specifically, independent claim 1, as amended, is directed to an eye drops container having a dent portion. The container includes a flexible hollow cylindrical barrel portion defining a dent portion, which can be gripped with two fingers. Further, the container instills its contents by a pressing force of about 1.78 to about 3.34N.

JP ‘975 is directed to a drop-dispensing container 1. The container is substantially flat and includes dent portions 4 and 5. By applying pressure to dent portions 4 and 5, a liquid is excreted from nozzle 6 on the container 1. It appears that the Examiner is using JP ‘927 for its disclosure of a bottle that can be gripped or squeezed in order to instill a liquid material.

Fig. 13 of the present application has also been amended through the foregoing Amendment, such that this figure illustrates a prior art bottle structure. The walls 2 of the bottle shown in Fig. 13 are flat and have no dent portions displaced thereon. The Lier patent is directed to a package for free-flowing products. Two opposite gripping recesses 6 are impressed in the wall surface of the product container 2. By applying pressure to these gripping recesses 6 in the direction of arrows 7, the product container 2 can readily be compressed so that fluid product flows out through the dispensing nozzle 3 in a small and exact amount. It appears that the Examiner believes that the mere provision of finger gripping recesses or dents in a conventional dropper bottle (as seen in Fig. 13 of the present application) for controlled dispensing of the contents is obvious in view of the Lier patent. See Fig. 2.

The Keiter patent is directed to a flexible container for dispensing predetermined

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quantities and materials. The container includes a body 20 and a pair of opposing wall surface regions 22 and 24. Each of these regions has a depression 26 extending to a face 28, and the faces 28 are aligned in opposition to each other at a spaced distance 30. It appears that the Examiner is using the Keiter patent for its disclosure of a dent with a flat profile or concave profile.

The Lifshey patent is directed to an ophthalmic package and delivery device. It appears that the Examiner is using the Lifshey patent (or alternatively EP '725) for its teaching of a container body manufactured from a thermoplastic resin material, which is filled with a solution simultaneously with its forming operation. The package of the Lifshey patent is manufactured by using an injection molding process.

A primary goal of the structure of the present invention is to provide a container with superior squeezeability characteristics, which allow instillation to proceed in an accurate and easy manner. In order to achieve this superior squeezeability, the eye drops container includes a dent portion, and the container includes a flexible hollow cylindrical barrel portion that defines this dent portion and can be gripped with two fingers. Importantly, independent claim 1, as amended, now specifically recites that the container instills its contents by a pressing force of about 1.78 to about 3.34N. This claim amendment is fully supported in the specification. Further, it is the ability of the structure to provide a predetermined amount of material from the container through the specifically identified pressing force of 1.78 to 3.34N.

The pressing operational force of 1.78 to 3.34N, as set forth in the present application, is not taught or suggested in any of the references cited by the Examiner, the references provided by the Applicants, nor any of the prior art of record. Specifically, these references are silent on how to design the structure of the eye drops container to achieve the

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specified pressing operational force, which, in turn, provides for improved squeezeability. For these reasons, none of JP '975, JP '927, Fig. 13 of the present application, the Lier patent, the Keiter patent, EP '725 nor the Lifshey patent teach or suggest an eye drops container with a dent portion, where the container instills its contents by a pressing force of 1.78 to 3.34N, as specifically set forth in independent claim 1, as amended.

For the foregoing reasons, independent claim 1, as amended, is not anticipated by or rendered obvious over the JP '975, JP '927, Fig. 13 of the present application, the Lier patent, the Keiter patent, EP '725 nor the Lifshey, whether used alone or in combination. There is no hint or suggestion in any of the references cited by the Examiner to combine these references in a manner which would render the invention, as claimed, obvious. Reconsideration of the rejection of independent claim 1 is respectfully requested.

It is noted that, with respect to claims 3-6, the Examiner has used various prior art references to cure the deficiencies of the primary references. For example, the Examiner has rejected claims 4-6 as being obvious over JP '975, JP'927, Fig. 13 of the present application, the Lier patent, the Keiter patent, EP '725 as well as the Lifshey patent. As set forth in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. Further, the Examiner cannot use the claims as a blueprint for locating separate claim elements in separate prior art references without considering the teachings of the prior art as a whole and without considering the complete teachings of the separate references. There is no incentive to combine the seven above-listed references together in order to arrive at the claimed subject matter of the present application. Such a combination would constitute hindsight reconstruction. In the absence of some "clear and particular" motivation to combine the teachings of the cited prior art, the

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objection is improper. Winner Int'l Royalty Corp. v Wang, 202 F.3d 1340, 1348-49 (Fed. Cir. 2000).

For the foregoing reasons, none of pending claims 1-9 is anticipated by or rendered obvious over JP '975, JP '927, Fig. 13 of the present application, the Lier patent, the Keiter patent, EP '725 or the Lifshey patent, whether used alone or in combination. There is no hint or suggestion in any of the references cited by the Examiner to combine these references in a manner which would render the invention, as claimed, obvious. Further, claims 2-9 depend either directly or indirectly from and add further limitations to independent claim 1 and are believed to be allowable for the reasons discussed hereinabove in connection with independent claim 1. Still further, with respect to newly-added dependent claims 7-9, in the case of the container as defined in new dependent claim 7, the container is made of 2.0 to 2.4 g of polyethylene, and this material typically has a poor squeezeability characteristic. However, this characteristic is well compensated for by the presence of the dent portion which improves the squeezeability, where the container can still excrete the contents by a pressing force as defined in independent claim 1. Similarly, newly-added dependent claim 8 is directed to a container having rather disadvantageous dimensions for squeezeability. However, the dimensions are compensated for by the presence of the dent portion for squeezeability improvement, together with the pressing force taught in independent claim 1. Finally, newly-added dependent claim 9 introduces a particular shape and dimension that increases and is advantageous for the squeezeability of a container. Accordingly, with all the features set forth in the independent and dependent claims, the eye drops container of the present invention achieves the advantages of being ready to carry, accurate and easy to instill the medical liquid contained therein by the particular mode of the user's action of lifting his/her hand over the eye. These features represent

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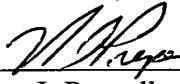
significant improvements in the art, and specifically in the area of dispensing containers. Therefore, for all the above reasons, reconsideration of the rejections of dependent claims 2-9 is respectfully requested.

For all the foregoing reasons, Applicants believe that claims 1-9, as amended and added, are patentable over the cited prior art and in condition for allowance. Reconsideration of rejections and allowance of all pending claims 1-9 are respectfully requested.

Respectfully submitted,

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ANNOTATED SHEET

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Fig. 1

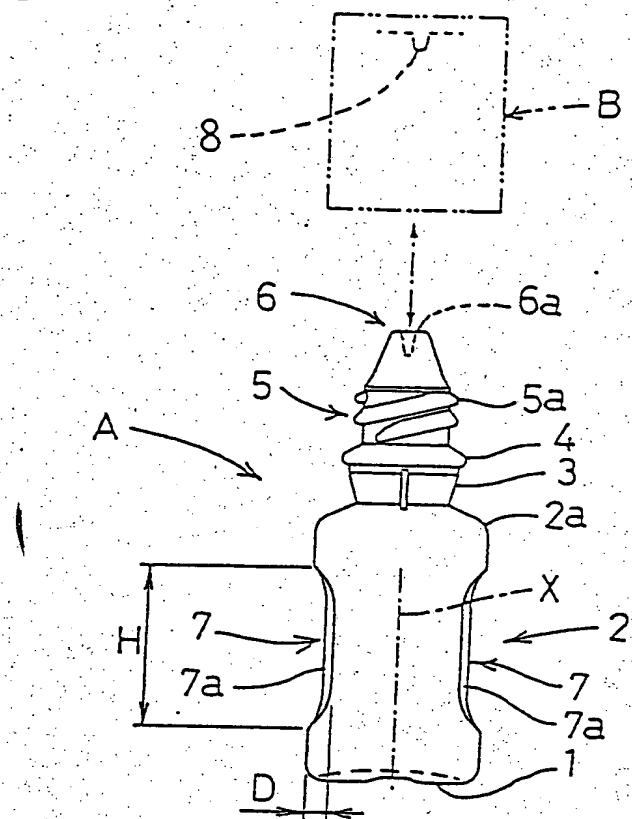
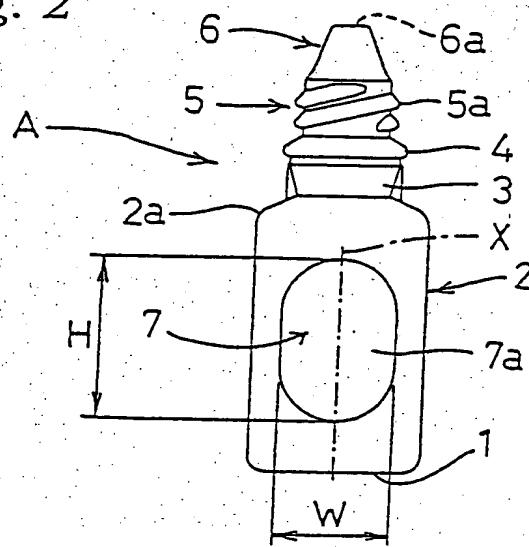


Fig. 2





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Fig. 3

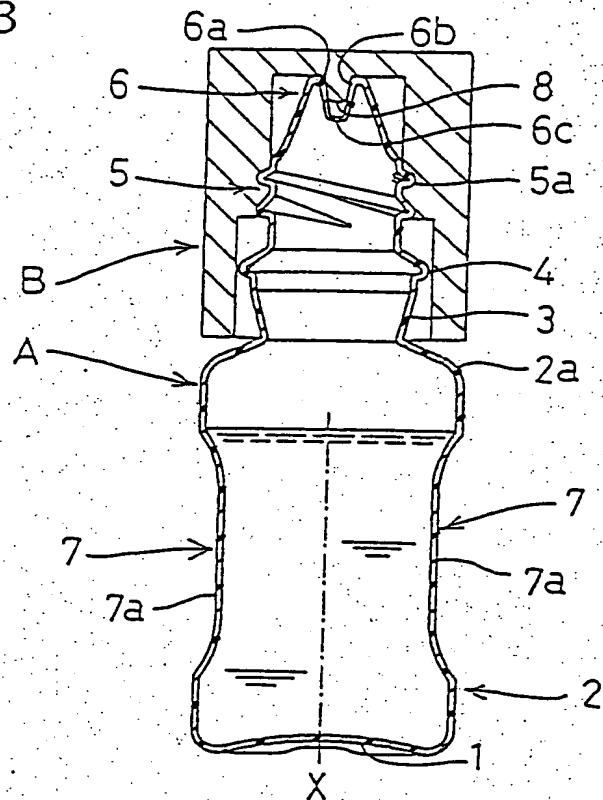
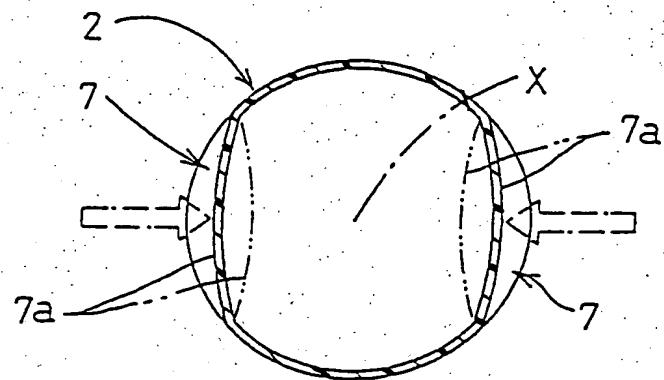


Fig. 4



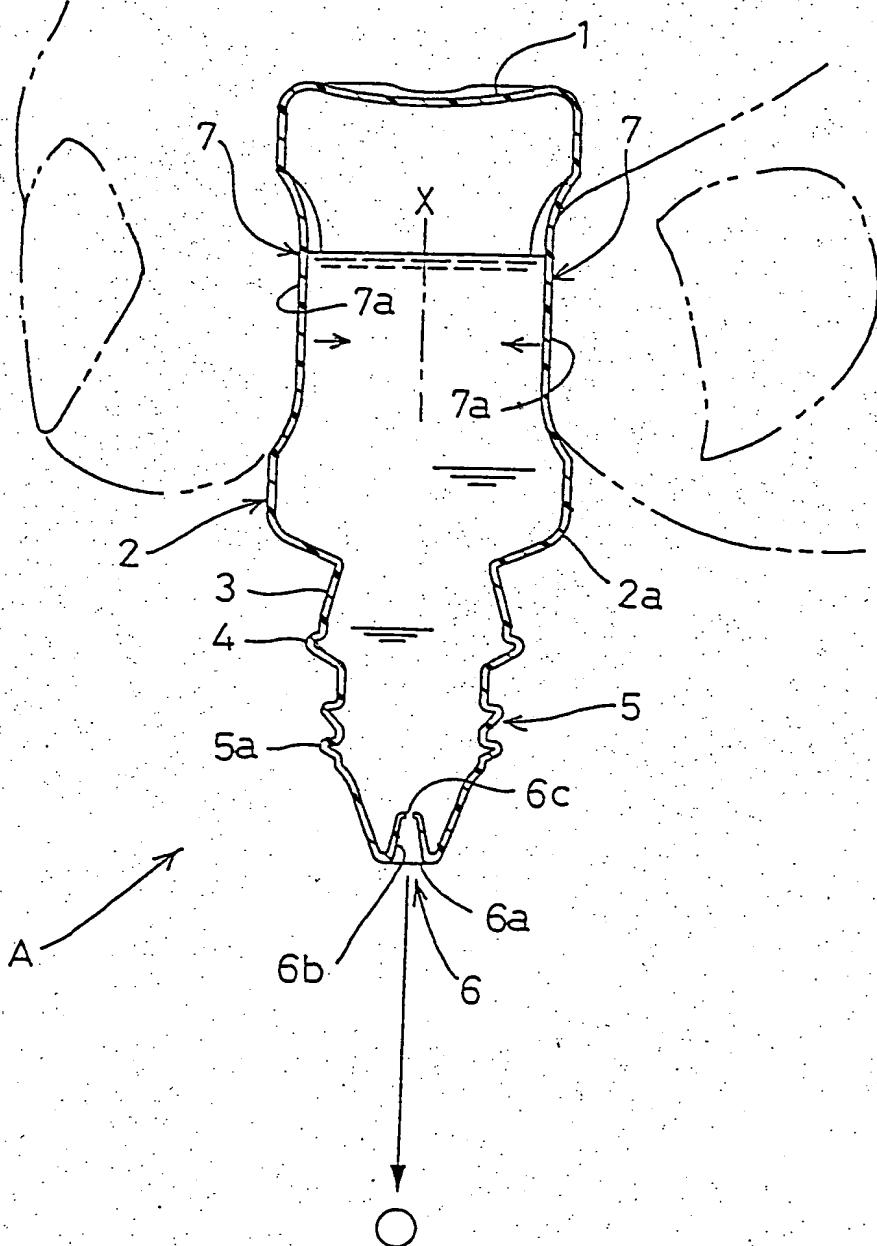


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Fig. 5





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Fig. 6

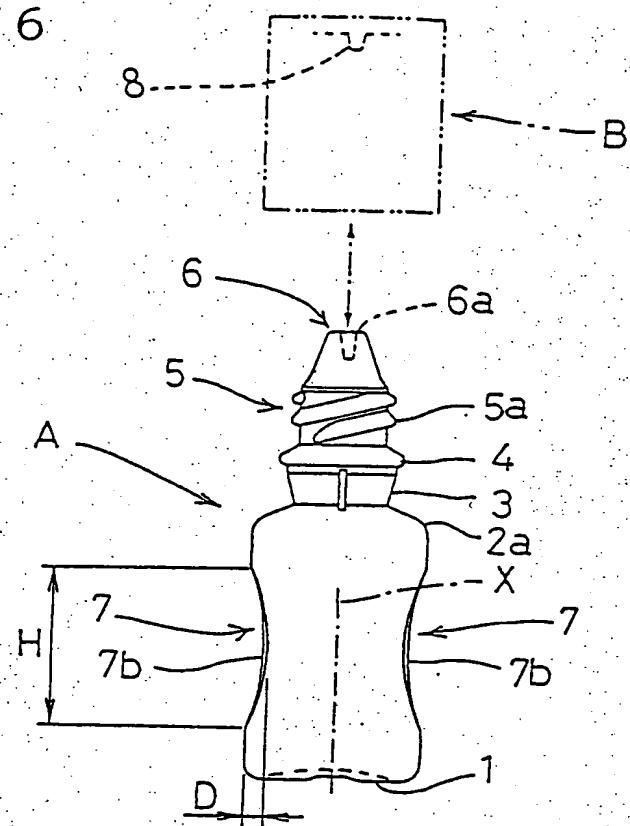
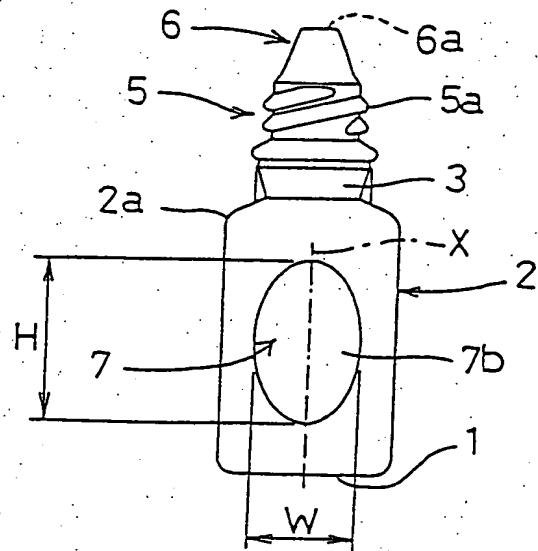


Fig. 7





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Fig. 8

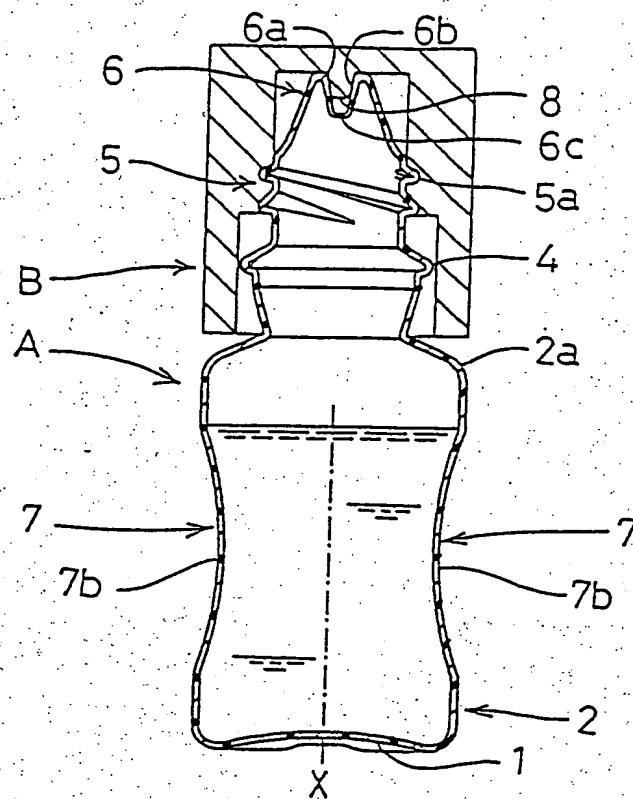
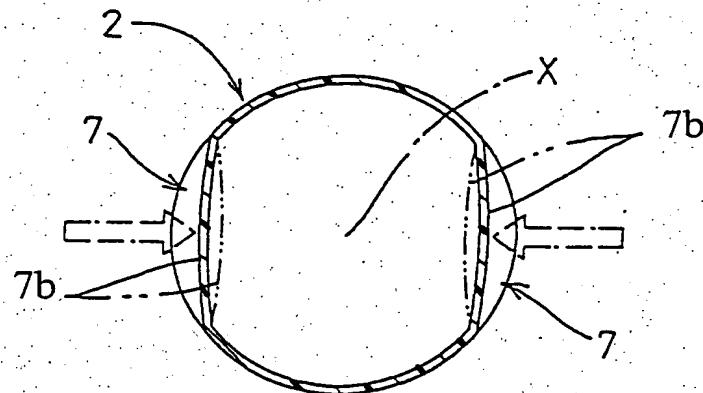
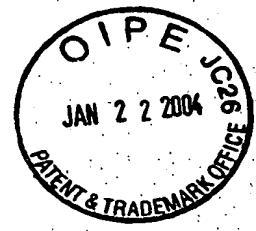


Fig. 9



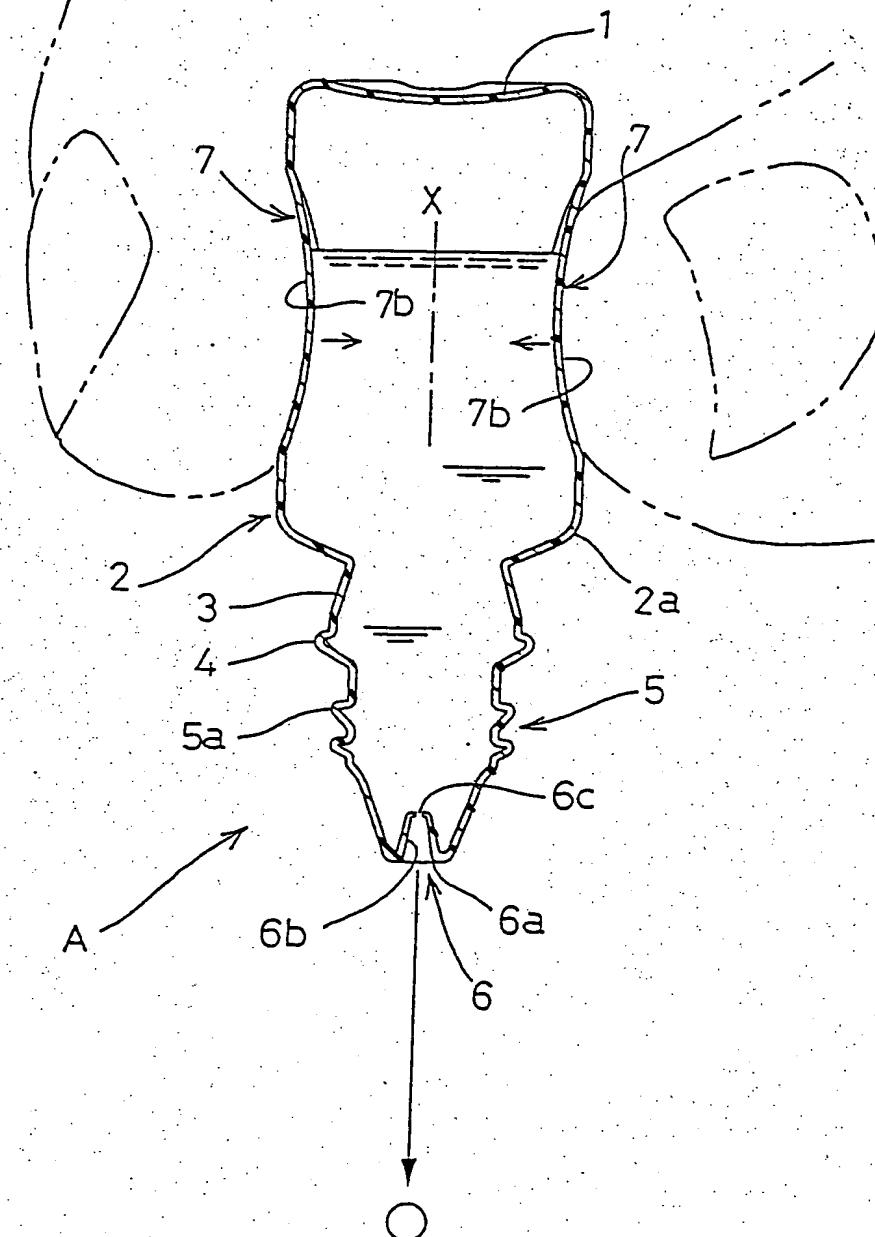


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Fig. 10





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Fig. 11

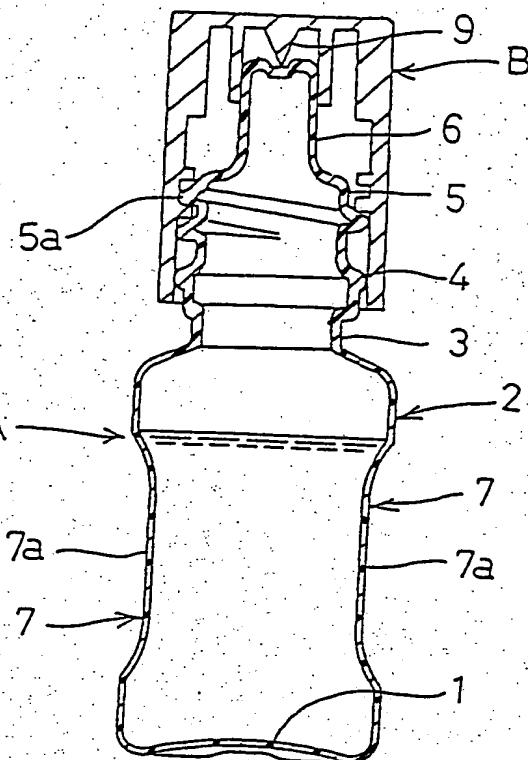
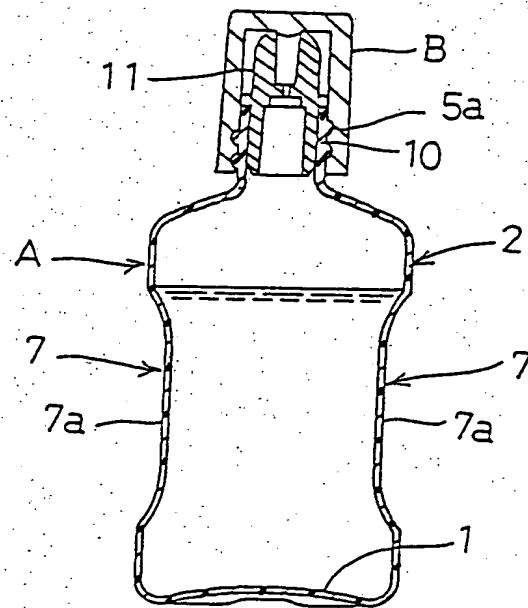


Fig. 12



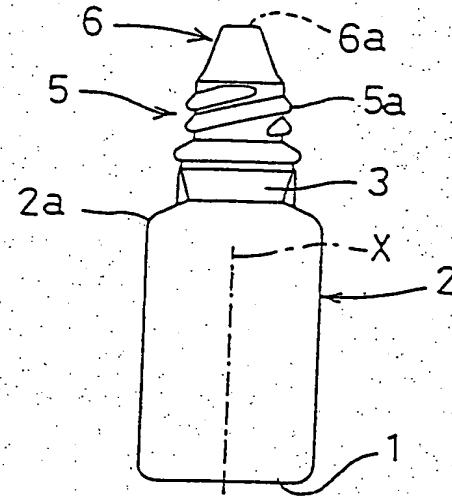
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Fig. 13



(PRIOR ART)